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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,765	01/05/2004	Valerie de la Poterie	5725.0479-01	1698
22852 7590 04/30/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
			EXAMINER ALSTRUM ACEVEDO, JAMES HENRY	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 04/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/750,765

Applicant(s)

DE LA POTERIE, VALERIE

Examiner

James H. Alstrum-Acevedo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☒ Certified copies of the priority documents have been received in Application No. 09/437,109.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-39 are pending. Applicants amended claims 1 and 30-32. Receipt and consideration of Applicant's amended claims and arguments/remarks submitted on February 6, 2007 are acknowledged. Applicants' amendments have necessitated a new rejection.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file of parent application No. 09/437,109 (now abandoned).

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of claims 1-39 under 35 U.S.C. 102(b) as being anticipated by Mougin et al. (WO 97/00662, published January 9, 1997) using U.S. Patent No. 5,945,095 as its English language equivalent **is withdrawn** per Applicants' claim amendments requiring that the fat-soluble rheological agent is different from the stabilizing agent.

Response to Arguments

Applicant's arguments, see pages 11-13, filed February 6, 2007, with respect to the rejection(s) of claim(s) claims 1-39 under 35 U.S.C. 102(b) as being anticipated by Mougin et al. (WO 97/00662, published January 9, 1997) using U.S. Patent No. 5,945,095 as its English language equivalent have been fully considered and are persuasive. Therefore, the rejection has

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been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art (see the following rejection under 35 U.S.C. § 103(a)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-39 are rejected under 35 U.S.C. 103(a) as being obvious over Mougin et al. (WO 97/00662, published January 9, 1997), using U.S. Patent No. 5,945,095 as its English language equivalent, and in view of Tsaor et al. (U.S. Patent No. 5,804,540).

Applicant Claims

Applicant claims (1) a composition for topical application comprising (a) a liquid fatty phase, (b) a fat soluble rheological agent (i.e. thickener), (c) polymer particles dispersed in the liquid fatty phase, and (d) a stabilizing agent that stabilizes the polymer particles at the surface of the liquid fatty phase, wherein the fat-soluble rheological agent is different from the stabilizing agent; (2) a process for making (1) comprising (a) dispersing particles of at least one polymer in a liquid fatty phase, (b) stabilizing said particles with a stabilizing agent, (c) polymerizing at least one monomer possessing an ethylenic bond to form a fat-soluble rheological agent that is different from said stabilizing agent; (3) a process for cosmetic care of or for making up the lips

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or skin comprising applying the composition of (1) to the lips or skin; and (4) a process for limiting or eliminating the transfer of a composition for making up or caring for the skin or lips onto a substrate other than the skin or lips comprising (a) introducing into a liquid fatty phase which comprises at least one cosmetic, dermatological, hygiene, or pharmaceutical active principle, a fat-soluble rheological agent resulting from the polymerization of at least one ethylenic monomer and dispersible polymer particles that can be stabilized with stabilizing agent.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Mougin teaches a (1) cosmetic composition comprising fatty substances and pulverulent compounds comprising a dispersion of surface-stabilized polymer particles in a liquid fatty substance; (2) a cast product comprising at least one wax, comprising a dispersion of crosslinked and surface-stabilized polymer particles in a cosmetically, dermatologically, hygienically or pharmaceutically acceptable liquid fatty substance; and (3) a compact powder, comprising a fatty binder and pulverulent compounds, comprising a dispersion of surface-stabilized polymer particles in a cosmetically, dermatologically, pharmaceutically or hygienically acceptable liquid fatty substance (column 2, lines 63-67 and column 3, lines 1-5), wherein the stabilizing polymers are non-film formers (column 3, lines 12-14). Cosmetic compositions applied to the skin or the lips as make-up or care product (lip bases, lipsticks or foundations) generally contain fatty substances (e.g. waxes, oils, pigments and/or fillers and, possibly, additives)(column 1, lines 12-16). The film forming polymers may or may not be crosslinked and are vinyl or acrylic radical copolymers or homopolymers (e.g. polymethyl

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methacrylate or polystyrene) (column 4, lines 43-53). The polymers used in her invention may be of any nature – radical polymers, polycondensates, or polymers of natural origin (column 4, lines 8-11). Mougin discloses that the liquid fatty substance (i.e. the liquid fatty phase) may consist of any cosmetically or dermatologically acceptable oil, chosen from carbon-based, hydrocarbon, fluoro and/or silicone oils of mineral, animal, plant or synthetic origin, wherein specific examples are provided (column 4, lines 53-67 and column 5, lines 1-23). The stabilizing polymer used during the polymerization must be soluble or dispersible in the fatty substance (column 7, lines 10-12). Mougin teaches sequential or grafted block copolymers comprising at least one block resulting from the polymerization of dienes, and at least one block of a vinyl polymer, in particular of "diblock" or "triblock" type (e.g. polystyrene/polyisoprene, etc) (column 7, lines 38-48). The limitations of the following claims of the instant application: 12 (column 8, lines 18-39), 16 (column 6, lines 56-59), 17 (column 7, lines 13-26), 18 (column 7, lines 38-48), 19 (column 8, lines 47-53), 20 (column 9, lines 29-34), 25 (column 5, lines 20-24), 26 (column 10, lines 29-33 and column 10, lines 50-52), 27 (column 2, lines 44-50 and column 10, lines 50-52), 28 and 29 (column 10, lines 50-52), 30-32 (column 6, lines 25-67), 33-39 (column 5, lines 2-21). Mougin teaches that the compositions may comprise any additive usually used in such compositions including thickeners (i.e. rheological agents) and liposoluble polymers, such as polyalkylenes, in particular polybutene, polyacrylates, and silicone polymers that are compatible with fatty substances (col. 9, line 66 through col. 10, line 10).

Tsaur teaches personal wash liquid compositions comprising low viscosity oils pre-thickened by non-antifoaming hydrophobic polymers (title, abstract). Suitable thickeners taught by Tsaur include rubber-based thermoplastic copolymers such as SEBS, SEP, SEB, and SBS (S

= polystyrene segments; E = polyethylene segments; B = polybutylene or polybutadiene; and P = polypropylene) (col. 12, lines 35-45). These thickeners are available commercially from the Shell Chemical Company under the tradename KRATON®.

Ascertainment of the Difference Between Scope the Prior Art and the Claims

(MPEP §2141.012)

Mougin does not explicitly teach compositions comprising a rheological agent that is different from the stabilizing agent. This deficiency is cured by the teachings of Tsaur.

Finding of Prima Facie Obviousness Rational and Motivation

(MPEP §2142-2143)

It would have been obvious to a person of ordinary skill in the art at the time of the instant invention to combine the teachings of Mougin and Tsaur, because Mougin teaches invented compositions that may include additional additives such as thickeners and liposoluble polymers. An ordinary skilled artisan would have been motivated to combine the teaching of Mougin and Tsaur because these references are in the same field of endeavor and Mougin explicitly states that thickeners (i.e. rheological agents) may be included in the invented compositions. Furthermore, Mougin explicitly suggests that liposoluble polymers, such as those taught by Tsaur are suitable additives to the invented compositions. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Regarding the amounts of thickener, although Tsaur does not explicitly teach an amount of thickener absent an amount of oil, it would have been within the ability of an ordinary skilled artisan to optimize the amount of thickener to obtain a composition

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with the desired viscosity. The optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient needed to achieve the desired results. Absent some demonstration of unexpected results from the claimed parameters, the optimization of ingredient amounts would have been obvious at the time of applicant's invention. Furthermore, Applicants have not demonstrated the criticality of the amounts of thickener claimed in claims 6-7. Thus, an ordinary skilled artisan would have had a reasonable expectation of success upon combination of the prior art teachings and modification of Mougin's teachings to utilize Tsauro's thickeners, because said thickeners are liposoluble and Mougin also suggests the desirability of compositions comprising fat-soluble diblock and/or triblock polymers.

Applicant's specification has two claims of surprising observations: that one could obtain a film with good gloss, hold, little transfer (i.e. transfer free properties) upon combination of at least one polymer which is dispersible in a fatty phase, in combination with a specific rheological agent, in a cosmetic, dermatological, pharmaceutical or hygiene composition (see paragraphs 12 and 107 in the instant specification). Applicant has compared the claimed invention to prior art formulations using non-KRATON[®] thickeners (see table 1 on page 38 of the instant specification). These statements and data are insufficient to overcome the instant *prima facie* case of obviousness, because the combined prior art teaches a composition comprising the same rheological agents, liquid fatty phase, polymer particles, and stabilizing agent it would obviously exhibit the same or substantially similar properties. Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the

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invention was made, because the combined teachings of the prior art is fairly suggestive of the claimed invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The rejections of (1) claims 1 and 10 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,254,876 (USPN '876) and (2) claims 1 and 10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,254,877 (USPN '877) **are withdrawn**, per Applicant's amendment requiring that the fat-soluble rheological agent and stabilizer are different.

Response to Arguments

Applicant's arguments, see pages 14-15, filed February 6, 2007, with respect to the obviousness-type double patenting rejections over the cited claims of USPN '876 and USPN '877 have been fully considered and are persuasive. The obviousness-type double patenting rejections over the cited claims of USPN '876 and USPN '877 have been withdrawn.

The rejection of claims 1 and 10 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,682,748 (USPN '748) is maintained for the reasons of record set forth on pages 4-5 of the office action mailed on August 7, 2006. In addition, claim 90 of USPN '748 and claims 21, 23, and 32 of the instant application are appended to this rejection as further articulated herein and below. Independent claim 90 of USPN '748 teaches the method of claim 32 of the instant application and specifies that said composition contain a viscosity-enhancing polymer (i.e. rheological agent). Because claim 90 of USPN '748 depends from claims 1, 2, or 3 the composition used in said method comprises a coloring agent, and therefore this claim reads on claims 1 and 10 of the instant application. Claim 90 of USPN '748 also reads on claims 21 and 23 of the instant application because said claims do not require any additional components (i.e. 0-50% pulverant in claim 21 and 0-60% dry matter in claim 23).

Response to Arguments

Applicant's arguments filed February 6, 2007 have been fully considered but they are not persuasive. Applicant asserts that the requirement that the rheological agent be different than the

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stabilizing agent overcomes the instant rejection. This is found unpersuasive, because claim 90 of UPSN '748 clearly requires an additional viscosity-enhancing polymer and does not require that said viscosity-enhancing polymer be the same as the stabilizer.

Claims 1-7, 11, 13-14, 16-19, 21, 23-26, 28-29, and 33-39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5-16, 18-20, and 23-25 of U.S. Patent No. 5,945,095 (USPN '095). Although the conflicting claims are not identical, they are not patentably distinct from each other because they are overlapping in scope and mutually obvious. Independent claim 1 of UPSN '095 claims a cosmetic composition comprising (a) liquid fatty phase; (b) optionally at least one pulverant compound; (c) surface-stabilized polymer particles, selected from radical polymers, and (d) at least one surface-stabilizing polymer. Independent claim 1 of the instant application has been described above. It is noted that the language of the claims of the instant application requires that the stabilizing agent be different from the rheological agent. It is also noted that the cited claims of UPSN 095 require that the compositions comprise at least one surface-stabilizing polymer and does not require that all the surface stabilizing polymers be the same or preclude these from also acting as thickeners (i.e. rheological agents). Because the polymers of USPN '095 described as being suitable surface-stabilizing polymers include the same polymers described by the instant application as being suitable thickeners (e.g. KRATON[®] polymers), it is the Examiner's position that the cited claims of USPN '095 obviate the cited claims of the instant application. Furthermore, it is well with the skill of an ordinary artisan to adjust viscosity by modifying the amount of polymers (i.e. thickeners) present in a given composition. It is

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immaterial that the claims of USPN '095 refer to additional polymers as stabilizers and not rheological agents, because the genus of surface stabilizing polymers of USPN '095 encompasses the genus of polymers described in the claims of the instant application as being rheological agents. Regarding the other composition ingredients, substantially overlapping Markush groups are claimed in both the instant application and USPN '095.

Conclusion

Claims 1-39 are rejected. No claims are allowed.

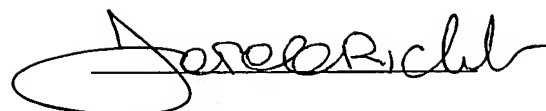
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Alstrum-Acevedo whose telephone number is (571) 272-5548. The examiner can normally be reached on M-F, 9:00-6:30, with every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0664. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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James H. Alstrum-Acevedo, Ph.D.
Patent Examiner
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A handwritten signature in black ink, appearing to read "Johann Richter". The signature is fluid and cursive, with a large loop at the beginning and a horizontal line extending from the middle.

Johann Richter, Ph. D., Esq.
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